



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,148	10/12/2000	John J. Sie	19281-001000US	8622

20350 7590 07/11/2006

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

BROWN, RUEBEN M

ART UNIT	PAPER NUMBER
----------	--------------

2623

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/687,148

Applicant(s)

SIE ET AL.

Examiner

Reuben M. Brown

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27, 32, 33 and 36 is/are rejected.
- 7) ☐ Claim(s) 28-31 & 34-35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 4/28/06 have been fully considered but they are not persuasive. Applicant main argument is that claims 24 & 36, require 'identifying when the user has tuned to particular program according to the schedule of programming, the particular program having a counterpart program on the server...'. Examiner agrees that this feature is more specific than the requirements of claim 1 and should be addressed individually. Applicant points out the features of the TV planner interface discussed in Proehl.

However, examiner notes that the viewer in Proehl selects TV programming directly from the main EPG interface, and the system indeed detects when a viewer selects a channel/program, since the system starts tuning to the particular program, see col. 5, lines 61-65 thru col. 6, lines 1-57. Thus, since the user in Proehl is clearly able to select and tune to at least a current broadcast program from the EPG, which would include any program previously listed as a future program, for instance in the TV planner, the combination of Proehl & Russo still reads on claimed subject matter.

When the viewer in Proehl selects and tunes to a program from the EPG that has the Record notification symbol, in combination with Russo, which teaches multiple programs being stored at the STB, the subject matter is met. Examiner notes that

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-27, 32-33 & 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Proehl, (U.S. Pat # 6,532, 589), in view of Russo, (U.S. Pat # 5,619,247).

Considering claim 1, the amended claimed method for ‘distributing programming comprising transmitting a first set of programs in real time’ reads on the discussion in Proehl that a plurality of programs may be broadcast to one or more subscribers, according to schedule, see Figs. 9-10 & col. 2, lines 20-45 & col. 6, lines 61-68. The ‘first set of programs’ corresponds with the programs that are stored in the system and may be broadcast to subscribers, see col. 3, lines 11-30.

As for the further claimed feature of the second set of programs having a counterpart substantially identical to the at least one of the first set of programs, Proehl teaches recording/storing at least one program at a subscriber’s site, see col. 8, lines 10-30 & Fig. 9-10.

However, Proehl does explicitly teach that 'a set of programs' may be stored. Nevertheless Russo, which is in the same field of endeavor teaches storing a plurality of programs that are transmitted to a subscriber, at a subscriber location, program storage unit 14, which reads on the claimed 'server', see col. 4, lines 10-30 & col. 5, lines 1-10. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Proehl with the teaching of a plurality of or set of programs, at least for the desirable advantage of providing the user with a library of choices, as disclosed by Russo, col. 5, lines 48-55 & col. 10, lines 50-65.

As for the specific recitation that 'each of the second set of programs is configured to be played under a user's control', Russo teaches the user the movies may be stored on a conventional VCR, (col. 3, lines 50-53) which inherently support VCR commands. Also see Russo, col. 5, lines 10-18.

The additionally claimed feature of 'transmitting a notification signal to distinguish at least one of the second of programs on the server from the programs not on the server', reads on the discussion in Russo that the system displays a list of programs stored a the subscriber's site, col. 5, lines 45-55.

Art Unit: 2623

Considering claim 2, the claimed step of identifying when a user has tuned to a particular program, corresponds with the user in Proehl selecting a movie from the EPG that has been recorded at the subscriber site, see Fig. 9.

As for the additional claimed feature of when the particular program 'having a counterpart program in the schedule of programs, superimposing a notification symbol on the particular program', Proehl shows that the programs that have been recorded on the subscriber's VCR and are displayed in the EPG, include an icon 920 which reads on the claimed 'notification symbol'; see Fig. 9; col. 7, lines 50-56 & col. 8, lines 10-45.

Considering claims 3, 7, 10, 15 and 22, Proehl uses an icon to provide a notification symbol.

Considering claims 4, 8, 11, 16 and 23, Proehl (which uses an icon) provides a notification symbol, whereas Russo teaches displaying a title, which reads on a alphanumeric symbol.

Considering claims 5 & 25, the claimed feature of 'detecting a user request for descriptive information regarding a particular program and transmitting the descriptive information', is met by the discussion in Proehl that teaches that the user may access additional information regarding TV programming, Fig. 10 & col. 8, lines 31-55. The additionally claimed feature of 'determining whether the particular program has a counterpart program stored on the

Art Unit: 2623

server' corresponds with subject matter mentioned above in the rejection of claim 2 of 'identifying' and is likewise treated.

As for the further claimed recitation of 'superimposing a notification symbol on the descriptive information of the particular program if it is determined that it has a counterpart stored on the server', the disclosure in Proehl displays the same icon on the descriptive information as in the listing of programming shown in the EPG, Fig. 9 & 10. Specifically Proehl discloses that descriptive information relating to a particular program is displayed to the user, along with the icon of recorded event, which reads on the claimed 'superimposing a notification symbol on the descriptive information'. Thus in Proehl, the icon symbolizing a recorded program is only attached to a video program descriptive data, in the instance that the program has been recorded, since the instant icon is only used to notify the user that a program, has in fact been recorded.

Considering claims 6 & 26, Proehl & Russo teach the use of remote control.

Considering claim 9, see Proehl (col. 7, lines 2-4 & col. 7, lines 55-58), which reads on the claimed feature. The additionally claimed feature of determining which shows within the menu have a counterpart stored on the server, and superimposing at least one notification symbol on the menu to denote each program with a counterpart on the server', corresponds with subject matter mentioned above in the rejection of claim 2, and is likewise treated.

In particular, Fig. 9 of Proehl shows that programs that have been recorded, (which corresponds with the second set of programs stored on the server) have a particular icon, whereas programs that have not been recorded do not have the same icon; see col. 2, lines 35-48; col. 7, lines 45-56; col. 8, lines 10-20.

Considering claim 12, Proehl (Fig. 10; col. 5, lines 30-61) teaches that the menu/EPG may contain additional information, related to the TV programming.

Considering claim 13, the claimed feature reads on the combination of Proehl & Russo, since Russo teaches a list of programs that are pre-recorded, col. 10, lines 49-67.

Considering claim 14, the claimed features correspond with subject matter mentioned above in the rejection of claim 9, and is likewise treated. As for the recited feature of a 'schedule of programming', as discussed above in the rejection of claim 1, Proehl reads on the claimed subject matter.

Considering claims 17-18, Russo teaches requiring an authorization before programs can be accessed, col. 4, lines 60-67.

Considering claim 19, Russo teaches that storage site may be optionally located remote from the subscriber, col. 4, lines 28-48.

Considering claim 20, Proehl (col. 6, lines 61-67) & Russo disclose storing video programming in the memory, at the user site, which reads on the claimed subject matter.

Considering claim 21, the claimed feature of providing a system to transmit a set of programs to a user, at least some of which are configured to also be available under control of the user corresponds with subject matter mentioned above in the rejection of claim 1, and is likewise analyzed.

Considering claims 24, 27 & 36, the claimed method steps for distributing programming, corresponds with subject matter mentioned above in the rejection of claims 1 & 2, and is likewise treated. As for the additionally claimed feature of 'identifying when the user has tuned to a particular program according to a schedule of programming, the particular program having a counterpart program on the server that is substantially identical to the particular program'; the viewer in Proehl selects TV programming directly from the main EPG interface, and the system indeed detects when a viewer selects a channel/program, since the system starts tuning to the particular program, see col. 5, lines 61-65 thru col. 6, lines 1-57. Thus, since the user in Proehl is clearly able to select and tune to at least a current broadcast program from the EPG, which would include any program previously listed as a future program, for instance in the TV planner, the combination of Proehl & Russo still reads on claimed subject matter.

Art Unit: 2623

Again it is noted that Russo teaches storing a plurality of programs on a server, also from a schedule of programming, Abstract & col. 4, lines 35-65.

Considering claim 32, Official Notice is taken that transmission of promotional information and advertising with TV programming was known in the art at the time the invention was made. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to operate the combination of Proehl & Russo so that promotional and advertisement transmitted along with regularly broadcast programs and those pre-recorded, at least in order to reduce the cost of the system advertisers generally pay to advertise their material.

Considering claim 33, the broadcast program in Proehl and those pre-recorded in Russo read on the claimed 'different standard'.

Allowable Subject Matter

4. Claims 28-31 & 34-35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2623

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7290 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown


HAI TRAN
PRIMARY EXAMINER